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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/063,990	05/31/2002	Scott Wolmuth	3970.1000-000	3829

21005 7590 10/19/2005

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EXAMINER	
NGUYEN, QUYNH H	
ART UNIT	**PAPER NUMBER**
2642	

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/063,990	WOLMUTH, SCOTT	
	Examiner	Art Unit	
	Quynh H. Nguyen	2642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 August 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *17-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *17-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed 8/4/05 has been entered. No claims have been amended. Claims 1-16 have been cancelled. Claims 17-33 have been added. Claims 17-33 are still pending in this application, with claims 1, 23, and 29 being independent.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Objections

3. Claims 23 and 29 are objected to because of the following informalities:

Claims 23 and 29 recite the limitation "if said user does not agree connect said user their selected number" should be -- if said user does not agree connect said user to their selected number --. For the purposes of examining, the claims will be interpreted as suggested above.

Claim Rejections - 35 USC § 103

4. Claims 17 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marino et al. (U.S. Patent 4,850,007) in view of Gregorek et al. (U.S. Patent 5,557,658).

As to claim 17, Marino et al. teach a system (*Fig. 1, advertising message system 13*) in which an advertisement (*advertising messages*) is played to a user *(Fig. 1 local telephone customer)* (col. 1, lines 44-49 and col. 2, lines 62-68) comprising:

a directory assistance to users (col. 1, lines 39-44); playing advertisements to the user (col. 1, lines 44-54).

Marino et al. do not teach selecting and playing advertisement to the user based on selection criteria.

Gregorek et al. teach a selection mean *(Fig. 1, audible generator 14 and message generator 16 in the communications system 10*) for using selection criteria *(using ANI to identify the network address of the user or calling telephone number, time of day, day of the week, etc)* to select said advertisement (col. 9, lines 5-15).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the feature of having a selection means for using selection criteria to select said advertisement, as taught by Gregorek, in Marino's advertising message system thus making the system more efficient by playing advertisements to the callers that tied to the callers' specific interests.

As to claim 19, Gregorek et al. teach the selection criteria is based on the user's geographical location (col. 9, lines 17-24).

As to claim 20, Gregorek et al. teach the selection criteria is based on the user's phone number (col. 9, lines 12-17).

As to claim 21, Marino et al. teach advertisements are stored in a memory means (col. 4, lines 64-66).

As to claim 22, Marino et al. teach the user is requesting directory assistance and toll services (col. 1, lines 39-44).

5. Claims 23, 25-29 and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marino et al. (U.S. Patent 4,850,007) in view of Gregorek et al. (U.S. Patent 5,557,658) and further in view of Hutcheson et al. (Pub. No.: US 2003/0032409).

As to claims 23 and 29, Marino et al. teach a system (*Fig. 1, advertising message system 13*) comprising: a telephone network connecting a user with the system in (col. 2, lines 51-61); the system having a processing means and a memory means for containing a plurality of advertisements (col. 4, lines 64-66); having directory assistance to a user (col. 1, lines 39-44); said system playing said advertisement to said user (col. 1, lines 44-49 and col. 2, lines 62-68).

Marino et al. do not teach a processing means for using selection criteria to select said advertisement based on the location of the user; asking the user if he or she want to be connected to be connected to the company I the advertisement, if the user agrees connecting the user to the company, if the user does not agrees connect the user to their selected number.

Gregorek et al. teach a processing means *(Fig. 1, audible generator 14 and message generator 16 in the communications system 10*) for using selection criteria *(using ANI to identify the network address of the user or calling telephone number, time of day, day of the week, etc)* and user's geographical location (col. 9, lines 17-24) to select said advertisement (col. 9, lines 5-15).

Hutcheson et al. teaches asking the user if he or she want to be connected to be connected to the company I the advertisement, if the user agrees connecting the user to the company (page 14, [0152]). In Applicant's own specification (page 3, [0015]), Applicant only stated, "press 1 to be transferred to (the advertiser) now" and did not mention about if the user does not agrees connect the user to their selected number. Therefore, Examiner would treat the limitation "if the user does not agrees connect the user to their selected number" as a default case.

It would have been obvious to one of ordinary skill in the art at the time the invention was made the feature of having a selection means for using selection criteria to select said advertisement, as taught by Gregorek, in Marino's advertising message system thus making the system more efficient by playing advertisements to the callers that tied to the callers' specific interests; and the feature of asking the user if he or she want to be connected to be connected to the company I the advertisement, if the user agrees connecting the user to the company, as taught by Hutcheson, in Marino's and Gregorek's systems thus making the system more efficient and user-friendly by connecting the user to the advertised company so that the user does not have to hang up the phone and making a separate call the advertisement company.

Claim 25 is rejected for the same reasons as discussed above with respect to claim 19.

Claims 26 and 31 are rejected for the same reasons as discussed above with respect to claim 20.

Claims 27 and 32 are rejected for the same reasons as discussed above with respect to claim 21.

Claims 28 and 33 are rejected for the same reasons as discussed above with respect to claim 22.

6. Claims 18, 24, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marino et al. (U.S. Patent 4,850,007) in view of Gregorek et al. (U.S. Patent 5,557,658), further in view of Hutcheson et al. (Pub. No.: US 2003/0032409) and further in view of Swix et al. (U.S. Patent 6,718,551).

As to claim 18, 24, and 30, Marino, Gregorek, and Hutcheson do not teach the selection criteria is based on Standard Industry codes.

Swix et al. teaches selection criteria is based on Standard Industry codes (col. 3, lines 3-11).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the standard industry codes as being one of the section criteria, as taught by Swix, in Mario's, Gregorek's, and Hutcheson's systems which indicate such user characteristics as employer and type of employer in order to deliver pertinent advertisements that the user would be interested in, as discussed by Swix (col. 3, lines 19-23).

Response to Arguments

7. Applicant's arguments with respect to claims 23-33 have been considered but are moot in view of the new ground(s) of rejection. Applicant's arguments are addressed in the above claims rejections.

Applicant's arguments filed 8/4/05 have been fully considered but they are not persuasive. Applicant argues that the basis for both Gregorek and Marino's patents is the act of connection parties while the Applicant's patent application is the act of what takes place after that connection is made. Examiner respectfully disagrees. The basis for both Gregorek and Marino's take place after the connection is made because advertisements can only play after the connection is made.

Applicant's argues that Applicant's invention "goes much deeper into the consumer and find what they are interested in at that very moment". This is not in the claims.

Applicant argues that both Marino and Gregorek's advertisement being played is generalized and non-targeted. Examiner respectfully disagrees. Gregorek teaches a processing means *(Fig. 1, audible generator 14 and message generator 16 in the communications system 10)* for using selection criteria *(using ANI to identify the network address of the user or calling telephone number, time of day, day of the week, etc)* and user's geographical location (col. 9, lines 17-24) to select said advertisement (col. 9, lines 5-15).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., A highly honed tool compared to a rock affixed to a stick is the very equivalent of

the difference to this type of patent... The hammer is patentable because of its highly evolved state and so is the delivering of an ad based on the directory assistance listing request of a caller; The Applicant's invention is a highly specific message targeted to a specific caller and does not involve dial tone and carrying phone service but processing a completed call; The Applicant's application only deals with existing networks and completed calls it does not modify the callers network by use of software or otherwise; Applicant's invention does not connect users to the same station in a forum or chat type environment and only takes place once a typical call is placed and received and over existing, not modified network facilities, etc) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quynh H. Nguyen whose telephone number is 571-272-7489. The examiner can normally be reached on Monday - Thursday from 6:15 A.M. to 4:45 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on 571-272-7488. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Quynh H. Nguyen

October 13, 2005

BING Q. BUI
PRIMARY EXAMINER